



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/448,005	11/23/1999	DAVID L. SALGADO	690-008858-U	4554

7590 05/07/2003  
JANIK MARCOVICI  
PERMAN & GREEN LLP  
425 POST ROAD  
FAIRFIELD, CT 06430

EXAMINER

SHERRILL, JASON L

ART UNIT PAPER NUMBER

2622

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/448,005

Applicant(s)

SALGADO ET AL.

Examiner

Jason L Sherrill

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/19/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 2/19/03 have been fully considered but they are not persuasive. Applicant argues that the primary reference, Hashimoto (U.S. Patent No. 5,907,319), does not disclose or suggest registering with the controller that the image on the medium is larger than a predetermined size, then forming with the controller a modified image from the image on the medium. Applicant also argues that the cropping and image resolution features in Hashimoto are "always on" and does not disclose or suggest that the controller makes cropping and image resolution features available for user selection if the size of the image being copied is larger than the predetermined image size.

Hashimoto teaches automatic image enlargement or reduction in conformity to the sheet size selected (col. 10, lines 27-30). Hashimoto also teaches a control section (Figs. 4 & 5) containing central processing units ("CPU", 131, Fig. 4, & 130, Fig. 5) to control sequencing and operation of the device (col. 7, line 36 – col. 8, line 63). It would be obvious to one of ordinary skill in the art at the time the invention was made to consider that the automatic image enlargement or reduction in conformity to the sheet size selected includes the determination whether the image on the medium is larger than a predetermined size since the reduced image which fits the sheet size is smaller than the original size of the image. It would have been obvious to one of ordinary skill in the art at the time the invention was made to consider that the determination that the image was smaller or larger than a predetermined size would have to be register with the controller ("CPU", 131, Fig. 4, & 130, Fig. 5) in order to carry out the enlargement or reduction operations. It also would have been obvious to one of ordinary skill in

Art Unit: 2622

the art to consider that the image is modified because it is enlarged or reduced according to a predetermine size.

Applicant's argument that the cropping and image resolution features in Hashimoto are "always on" and does not disclose or suggest that the controller makes cropping and image resolution features available for user selection if the size or the image being copied is larger than the predetermined image size is not persuasive. As the Applicant argues, the cropping and image resolution features in Hashimoto are "always on", and therefore present for user selection if the size or the image being copied is larger than the predetermined image size, and would perform the same functions of the claimed invention.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 5, 6, 7, 9-13, 16-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al (U.S. Patent No. 5,907,319).

For claims 16 and 18, Hashimoto discloses an image transfer device (Fig. 2) for transferring an image disposed on a medium, the image transfer device comprising a reader (15, Fig. 2) operably connected to the controller for reading the on the medium (col. 4 line 24 – col.

Art Unit: 2622

7, line 35); a controller (CPU 130, Fig. 4) programmed to operate the image transfer device for performing of user selectable image transfer operations (col. 9, lines 4-35; col. 10, lines 17-22) to compare the size of the image on the medium with a size of a selected sheet and to form a modified image of the image on the medium (col. 10, lines 18-30), in response to user selection of a predetermined image transfer operation from the number of user selectable image transfer operations (Figs. 6, 8, 9, 10; col. 8, line 66 – col. 9 line 31; col. 10, line 10-38).

Hashimoto fails to directly teach that the controller is programmed for determining if the image on the medium is larger than a predetermined size. However, Hashimoto teaches automatic image reduction in conformity to the sheet size selected (col. 10, lines 27-30). It would be obvious to one of ordinary skill in the art at the time the invention was made to consider that the automatic image reduction in conformity to the sheet size selected includes the determination whether the image on the medium is larger than a predetermined size since the reduced image which fits the sheet size is smaller than the original size of the image. It would have been obvious to one of ordinary skill in the art to consider the modified image is smaller than the predetermined size in case the printed sheets have margins. The advantage of this automatic reduction is that the complete image is reduced to fit on to the sheet size selected and would improve the appearance of the image.

For claim 17, Hashimoto fails to directly teach an image transfer device wherein the modified image is smaller than the predetermined size (col.10, lines 26-30). However, it was commonly known in the art that an image printed on a sheet has margins wherein the image must be smaller than the predetermined size (selected sheet size) in order to fit within the margins of the pre-selected sheet size.

For claim 19, Hashimoto discloses an image transfer device wherein the controller programming for forming the modified image comprises programming for reducing the image (266, Fig. 8; col. 10, lines 18-30).

For claims 5 and 20, Hashimoto further teaches the cropping of an image (col. 8, lines 22-36; col. 8, line 64 – col. 9, line 3).

Hashimoto fails to directly teach an image transfer device wherein the controller programming for reducing the image comprises at least one of performing an isotropic reduction of the image, or performing an anamorphic reduction of the image. However, Hashimoto discloses an image transfer device wherein the controller programming for reduction includes standard enlargement and reduction (isotropic reduction) and reduction of the image performed in conformity to the sheet size selected (anamorphic reduction) (col. 10, lines 26-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to consider the reduction mentioned in Hashimoto comprising of at least one of reduction uniformly in all directions (isotropic reduction), or reduction in different amounts in different directions (anamorphic reduction) since Hashimoto teaches a system that can perform magnification automatically or according to user selection (273, 268, Fig. 9; col. 10, lines 24-38).

Claim 1 is the method claim corresponding to apparatus claims 16 and 17 above. Claim 1 is rejected for the same rationales set forth for claims 16 and 17.

For claim 3, Hashimoto teaches a method wherein the step of forming the modified image is performed automatically by the controller when the controller registers that the image on the medium is larger than the predetermined size (col. 10, lines 26-30).

Art Unit: 2622

For claim 4, Hashimoto discloses a method wherein the step of forming the modified image comprises of reducing the image (266, Fig. 8; col. 10, lines 18-30).

For claim 6, Hashimoto fails to directly teach a method wherein reducing the image comprises at least one of performing an isotropic reduction of the image, or performing an anamorphic reduction of the image. However, Hashimoto discloses a method with standard enlargement and reduction (isotropic reduction) and with the reduction of the images is performed in conformity to the sheet size selected (anamorphic reduction) (col. 10, lines 26-30). It would be obvious to one of ordinary skill in the art at the time the invention was made that the reduction mentioned in Hashimoto would have to comprise of at least one of performing reduction uniformly in all directions (isotropic reduction), or performing reduction in different amounts in different directions (anamorphic reduction) since Hashimoto teaches a system that can perform magnification automatically or according to user selection.

For claim 7, Hashimoto discloses a method wherein forming the modified image comprises sending an electronic embodiment of the image on the medium from the reader to the controller (10, Fig. 2), and modifying the electronic embodiment to form the modified image, wherein the modified image is at least one of a cropped image or a reduced image (col. 4, lines 25-53).

Claim 23 is rejected as being disclosed in claims 16 and 20 discussed above in reference to Hashimoto ('319').

Claims 9-13 are method claims corresponding to apparatus claims 16-20. Claims 9-13 are rejected for the same rationales discussed for claims 16-20 above.

Art Unit: 2622

4. Claims 2, 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto ('319') as applied to claims 1 and 16 above, and further in view of Barrett et al (U.S. Patent No. 5,301,036).

For claims 2, 14, and 22, Hashimoto fails to teach a method comprising the step of rotating with the controller the modified image wherein when the modified image is transferred onto a different medium the modified image on the different medium is rotated in comparison to an orientation of the image on the medium.

Barrett discloses an image transfer device and method capable of image orientation control comprising the step of rotating with the controller (7, Fig. 2) the modified image wherein when the modified image is transferred onto a different medium the modified image on the different medium is rotated in comparison to an orientation of the image on the medium (col. 1, lines 38-55; col. 6, line 68 – col. 5, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image forming method and apparatus of Hashimoto with the ability to orientate images as taught in Barrett so that the modified image is rotated in comparison to the original image because both teach image forming methods and apparatuses that modify an image before outputting the image on a medium. The improvement on Hashimoto by Barrett would allow for images to be orientated for the best presentation on the medium for which the image is to be displayed.

5. Claims 8, 15, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto ('319') as applied to claims 1 and 16 above, and further in view of Salgado (U.S. Patent No. 5,946,527).

For claims 8, 15, and 21, Hashimoto fails to teach an image transfer device and method comprising the step of displaying a warning message with the controller on a display of the image transfer device, the controller displaying the warning message on the display in response to registering that the image on the medium is larger than the predetermined size.

Salgado discloses an image transfer device and method comprising the means and steps of displaying a warning message with the controller (100, Fig. 1) on a display (22, Fig. 1) of the image transfer device (10, Fig. 1), the controller displaying the warning message on the display in response to registering that the image on the medium is larger than the predetermined size (col. 6, line 52 – col. 7, line 20; col. 8, lines 11-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Hashimoto with the ability of displaying a warning on the display as taught in Salgado because both Hashimoto and Salgado teach image reproduction methods and apparatuses with reduction and enlargement functions for image editing. The improvement of Hashimoto by Salgado would allow for a user to be notified when an image is larger than a medium of predetermined size permitting prompt action to be taken.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2622

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Satoh et al (U.S. Patent No. 5,930,001) discloses an image processing apparatus, which rotates an image in conformity with the orientation of the original.

b. Shirley (U.S. Patent No. 4,394,693) discloses a system for generating enlarged or reduced images.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L Sherrill whose telephone number is 703-306-4053. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5397 for regular communications and 703-306-5397 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


Application/Control Number: 09/448,005

Page 10

Art Unit: 2622

JLS

May 5, 2003

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600